# UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

*Ex parte* Rabindranath Dutta



Appeal No. 2006-0748
Application No. 09/740,528

ON BRIEF

Before KRASS, RUGGIERO, and BARRY, *Administrative Patent Judges.*
BARRY, *Administrative Patent Judge.*

A patent examiner rejected claims 1-3, 5-14, and 16-21. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

## I. BACKGROUND

The invention at issue on appeal administers an exam from a server to clients via a network. More specifically, an exam provider registers an exam with the server. The registered exam is provided to at least one student via the network. Based on answers submitted by the student, an exam result and a transcript, which documents the result, are generated. Access to the transcript is provided to third parties such as employers and admission boards. (Spec., p. 4, ¶ 1.)

A further understanding of the invention can be achieved by reading the following claim.

> 1. A method of administering exam content from a server to at least one client over a network, the method comprising:
>
> registering at least one exam submitted by an exam provider with the server;
>
> transmitting a video frame of a student to the server at least during the exam to verify the identity of the student;
>
> generating a transcript in response to answers submitted by the student to at least one exam question resident on the server; and
>
> providing access to the transcript to at least one third party.

Claims 1-3, 5-14, and 16-21 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,288,753 ("DeNicola").

## II. OPINION

"Rather than reiterate the positions of the examiner or the appellant *in toto*, we focus on the main point of contention therebetween." *Ex parte Sehr*, No. 2003-2165, 2005 WL 191041, at *2 (Bd.Pat.App & Int. 2004). The examiner asserts, "[I]t would have been obvious to choose archived video data of the examination day, (to verify the student taking the exam), along with other archived student and exam information, displaying the same simultaneously. This is particularly likely in light of the quality

control means also taught by DeNicola." (Examiner's Answer at 8.) The appellant argues, "There is no suggestion of transmitted student images with respect to either student testing in general or the Test Administrator in particular." (Appeal Br. at 9.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claims 1, 8, and 14 recite in pertinent part the following limitations: "transmitting a video frame of a student to the server at least during the exam to verify the identity of the student. . . ." Accordingly, the independent claims require

transmitting a video frame of a student to a server **while the student is taking an exam**.

B. OBVIOUSNESS DETERMINATION

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (Bd.Pat.App & Int. 2004). "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, DeNicola describes two systems, viz., "a live interactive distance learning system, and . . . an on-line testing, evaluation and reporting system." (Col. 1, ll. 6-8.) Of the two systems, only the live interactive distance learning system employs "a student classrooms display station 50," (Col. 8, l. 24), which "provide[s] [an]

instructor/actor with the ability . . . to observe the students themselves. . . ." (*Id.* at ll. 25-29.) Regarding the on-line testing, evaluation and reporting system, we agree with the appellant that "[t]here is no suggestion of transmitted student images with respect to either student testing in general or the Test Administrator in particular." (Appeal Br. at 9.)

"Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Here, we are uncertain how "the quality control means also taught by DeNicola," (Examiner's Answer at 8), would have suggested the desirability of modifying the reference's on-line testing, evaluation, and reporting system by adding the ability to observe "a student tak[ing] [an] exam." (Col. 13, l. 37.) Absent a teaching or

suggestion of transmitting a video frame of a student to a server while the student is taking an exam, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claims 1, 8, and 14 and of claims 2, 3, 5-7, 9-13, and 16-21, which depend therefrom.

## III. CONCLUSION

In summary, the rejection of claims 1-3, 5-14, and 16-21 under § 103(a) is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

GREG GOSHOM, P.C.
2110 W. SLAUGHTER LANE
SUITE 115-119
AUSTIN, TX 78652